of U.S. Patent No. 5,283,856 to Gross *et al.* ("Gross"). The Examiner further rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over the Hall reference in view of the Gross reference as applied to claim 5 and further in view of U.S. Patent No. 6,092,101 to Birrell *et al.* ("Birrell"). The Examiner rejected claim 10 under 35 U.S.C § 103(a) as being unpatentable over the Hall reference in view of Gross and further in view of Birrell as applied to claim 9 and still further in view of a Microsoft Corporation document, *"Excerpts from Online Documentation of Microsoft Exchange"*, version 5.0.1458.47, pp.1986-1997. Claim 17 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the Hall reference in view of the Gross reference as applied to claim 5 and further in view of U.S. Patent No. 5,619,648 to Canale *et al.*("Canale"). Applicant disagrees with these grounds of rejection and wishes to clarify various distinctions of applicant's invention over the cited art. Reconsideration is therefore requested in light of the following remarks.

The disclosed embodiments of the invention will now be discussed in comparison to the prior art. Of course, the discussion of the disclosed embodiments, as well as the discussion of the differences between the disclosed embodiments and the prior art subject matter do not define the scope or interpretation of any of the claims. Instead, such discussed differences are offered merely to help the Examiner appreciate important claim distinctions as they are discussed.

The disclosed embodiments of the present invention relate to a method and system for directing received e-mail messages to one of at least two user folders maintained on an e-mail recipient's computer. The received messages are placed in the one of at least two folders depending upon criteria regarding the identity of the e-mail sender. In one disclosed embodiment of the present invention, a list of senders who are authorized to send e-mail messages to a user is maintained. The disclosed method then intercepts e-mail messages that are sent to the user before they are placed in the user's default location for storing received messages. For example, this default location may be the user's Inbox message folder. The sender of the e-mail message is then compared with the identities on the list. The sender is thus identified if the sender's identity appears on the list. If it is determined that the intercepted message is from an authorized sender, the message is handled in the manner prescribed for receiving messages; *i.e.*, the message is stored in the user's Inbox folder. If it is determined that

the intercepted e-mail message is not from an authorized sender, the method may handle the message in a variety of ways. For example, the intercepted e-mail message may be stored in a pre-designated location, such as a "Junk Mail" folder. Alternatively, the intercepted e-mail message may simply be deleted, or forwarded to another user for manual processing. The message may also be displayed in a user's Inbox folder, but be displayed with a distinct and user-recognizable visual format to indicate that the message originated from an unauthorized sender. For example, a distinct and user-recognizable visual format may include dimming an icon representing the message on the user's display. Accordingly, a user may effectively filter out e-mail messages from unauthorized senders, thus potentially reducing the number of unwanted e-mail messages that a user would otherwise have to review.

The list of authorized e-mail senders may be generated in several ways, which may involve various automated techniques. For example, e-mail messages that were previously sent, or are currently being sent by a user may be examined, and the identifications for the recipients may be added to the authorized sender list. Previously received e-mail messages, which have been retained by a user after being read may also be scanned and the identifications of the senders may be added to the authorized sender list.

The Hall reference has been cited by the Examiner as pertinent to the patentability of the claims in the present application. Hall discloses a system and a method for sending and receiving authorized messages from a sender to a recipient in a network. The Hall reference uses "channelized" addresses to allow correspondents to send and receive e-mail messages. The channelized addresses thus permit correspondents to send e-mail to the user through a user-specified channel. Each channel has a distinct, structured e-mail address that includes an account name and a cryptographically generated random string called a "channel identifier". E-mail thus received that does not arrive on a proper channel (*e.g.* not having a proper channelized address) is rejected. (col. 5, lines 5-17). If unwanted e-mail does arrive on a user designated channel, the user turns off the previously designated channel and further designates a new channel so that legitimate users may continue to correspond with the user. In essence, valid users are "switched" to a different channel when unwanted e-mail messages arrive on the designated channel. (col. 5, lines 19-24).

With reference now to Figure 6 of the Hall reference, the process for receiving an e-mail message is shown in greater detail. At step 602, a mail server associated with the user receives an e-mail message from a network. At step 504, the received e-mail message is compared with a list of known users, with the channel identifier 110 (see Figure 4) removed (col. 12, lines 9-11). If the received e-mail message is *not* from a known user, the message is then *rejected,* and a corresponding e-mail message is returned to the sender stating that the message is from an "unknown user". (Emphasis added). Further, at step 608, the channel identifier 110 is compared with a list of known channel identifiers to determine if the message is authorized. Again, if the channel identifier is not on the list, the message is *rejected* and a "no permission" message is returned to the sender. The Examiner is further referred to col. 12, lines 4-25.

Thus, the Hall reference teaches that unwanted e-mail messages are avoided by "switching" valid users to *a different channel,* so that further unwanted e-mail messages are avoided entirely. As a consequence, the unwanted e-mail messages become *unavailable to the user* for any further processing or sorting. The Hall reference further teaches that if unwanted e-mail messages are received by the user, the messages are simply *rejected* if either the user name and/or the channel identifier do not appear on respective authorized lists, as shown in Figure 6. Figure 6 does not disclose that unauthorized messages are saved, or directed to other folders on a user's machine, nor does it disclose that the unauthorized messages are further processed or sorted. Furthermore, Hall *fails to disclose that the unwanted messages are even available to a user for further processing or sorting.* In fact, the only reference regarding the disposition of unwanted messages that the undersigned attorney has been able to find in the Hall reference states that: *"...unauthenticated messages are discarded unseen."* (Emphasis added). The Examiner is directed to col. 22, lines 15 through 20 for this teaching. Applicant therefore understands the Hall reference to teach that unwanted e-mail messages are *"rejected"* or *"discarded unseen"*, and are therefore not available for any further sorting or processing.

Accordingly, applicant asserts that the Hall reference does not permit any further processing or sorting since the rejected and discarded messages is *discarded without the user's awareness of its existence.* Additionally, applicant asserts that the Hall reference clearly *teaches away* from the present method, since Hall teaches that when an unwanted message arrives in a

user-designated channel that is not configured for the unwanted message, *the user merely switches to a different channel so that the unwanted messages never reach* the user. Clearly, any proposed processing or sorting of unwanted messages is not possible since the message is unavailable to the user. Furthermore, the undersigned attorney has been unable to find any disclosure in the Hall reference of an intermediate location where the unwanted messages could be stored prior to sorting or processing.

The Examiner has admitted that the Hall reference fails to disclose that when the sender of an e-mail message is determined not to be authorized, the message is stored in a second folder that is designated for e-mail messages received from unauthorized senders. In order to supply the required teaching, the Examiner has cited the Gross reference. Gross discloses a rule-based messaging mechanism that includes a conditional test. Specifically, Gross discloses a "when-if-then" conditional test (col. 4, line 24) that the Examiner asserts could be used to sort or process unwanted e-mail messages once they are received by a user of the disclosed Hall system.

As described more fully above, however, the system disclosed by Hall does not teach that unwanted e-mail messages are retained for sorting or processing. Again, Hall teaches the rejecting and discarding unwanted messages *unseen*. No intermediate storage or retention location is disclosed by Hall for the retention of such unwanted messages. Hall further discloses that when unwanted e-mail messages arrive through a designated channel, the user *switches away* from the channel, and provides a new channel. Thus, the unwanted messages are again entirely unavailable to a user for further processing or sorting, since the user no longer receives e-mail through the channel.

It is well understood that if a cited prior art reference requires modification in order to meet the claimed invention, or requires some modification in order to be properly combined with another reference, and such modification destroys the purpose or function of the invention disclosed in the reference, the references are not properly combinable since one skilled in the art would not be motivated to combine the references. In view of the references cited by the Examiner, and further in view of the combination proposed by the Examiner, applicant respectfully asserts that the Examiner has not presented a *prima facie* case of obviousness.

With reference again to the Hall and Gross references, applicant respectfully but strenuously asserts that the Hall reference would require *significant* modification in order to be

combined with Gross, as the Examiner asserts. In particular, unwanted e-mail messages would have to be preserved in order to be subjected to the conditional test as taught by Gross. Instead, Hall teaches that the unwanted messages are *rejected and discarded unseen*, and further that the user should switch the receiving channel so that no other unwanted messages are received. If *arguendo*, Hall were to be modified so that both desired and unwanted e-mail messages are received so that further processing and/or sorting could be performed using the conditional test of Gross, applicant asserts that the modification would render a central inventive aspect in Hall inoperative, since the discrete channels for routing e-mail messages, as taught in Hall, would be unnecessary.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

DORSEY & WHITNEY LLP

Steven H. Arterberry
Registration No. 46,314

SHA:sj

Enclosures:
    Postcard
    Check
    Fee Transmittal Sheet (+ copy)

1420 Fifth Avenue, Suite 3400
Seattle, WA 98101-4010
(206) 903-8800 (telephone)
(206) 903-8820 (fax)
\\sefile05\files2\ip\documents\clients\micron technology\100\500122.02\500122.02 amendment 082202.doc